

REMARKS

At the time the present Office Action was mailed (January 26, 2005), claims 1-42 were pending in the present application, with claims 3, 5, 12, 14 and 29-42 withdrawn. Claims 1, 3-10, 12-18, 26-34, 41, and 42 have been amended in this response, and new claims 43-51 have been added. Accordingly, claims 1-51 are currently pending, with claims 3, 5, 12, 14 and 29-42 withdrawn.

In the January 26, 2005 Office Action, the pending, non-withdrawn claims were rejected. More specifically, the status of the application in light of this Office Action is as follows:

(A) Claims 1, 2, 4, 10, 11, 13 and 28 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,938,688 to Schiff et al. ("Schiff"); and

(B) Claims 1 and 10 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,418,344 to Rezai et al. ("Rezai").

A. Response to the Section 102 Rejections on the Basis of Schiff

Claim 1, as currently amended, is directed to a method of effectuating a neural function in a patient. Claim 1 includes selecting a stimulation site at the cortex of the patient where a change in an intrinsic, patient-specific neural activity is suspected of occurring to carry out a particular physical function and/or cognitive function of the patient. The method further includes positioning an electrode at the selected stimulation site and applying an electrical signal to the stimulation site via the electrode.

Schiff is directed to a deep brain stimulation method. Schiff repeatedly states that his electrical stimulation is of deep brain structures, including the intralaminar nuclei and other thalamic nuclei (see Schiff at column 1, lines 58-59; column 2, lines 21-22; column 4, lines 60 and 66; column 5 at line 1, and lines 55-56; etc.). Accordingly, Schiff fails to disclose "selecting a stimulation site at the cortex" of a patient and "positioning an electrode at the selected stimulation site," as is included in claim 1 (emphasis

added). Schiff further fails to provide any motivation to modify his method to include stimulation at the cortex of a patient's brain. Accordingly, the Section 102 rejection of claim 1 on the basis of Schiff should be withdrawn.

Claims 2 and 4 depend from claim 1. Accordingly, the Section 102 rejection of claims 2 and 4 on the basis of Schiff should be withdrawn for the foregoing reasons and for the additional features of these claims.

Independent claims 10 and 28, as amended, include features generally similar to those described above with reference to claim 1. Accordingly, the Section 102 rejections of these claims should be withdrawn for the foregoing reasons and for the additional features of these claim.

Claims 11 and 13 depend from claim 10. Accordingly, the Section 102 rejections of these claims should be withdrawn for the foregoing reasons and for the additional features of these dependent claims.

B. Response to the Section 102 Rejections on the Basis of Rezai

Rezai is directed toward a method for treating psychiatric disorders using chemical and/or electrical neuromodulation. Rezai discloses treating psychiatric disorders in two separate stages. The first stage is identifying a common region of the orbital frontal cortex that exhibits pathological electrical and/or chemical activity during manifestations of a specific psychiatric disorder from a large sampling of patients that each exhibit the specific psychiatric disorder. (Column 5, lines 8-12.) The common region of the orbital frontal cortex associated with the particular pathological activity of the specific psychiatric disorder constitutes the predetermined treatment site for applying electrical and/or chemical stimulation. (Column 5, lines 12-14.) The second stage includes implanting an electrical stimulator and/or drug-delivery catheter at the predetermined treatment site. Rezai emphasizes that the predetermined treatment site must be within the orbital frontal cortex of the frontal cerebral cortex region to treat the relevant psychiatric disorders. Therefore, Rezai is limited to methods that require a

predetermined treatment site in the orbital frontal cortex that is determined by clinically identifying a common area in a large sampling of patients where deviations in normal electrical and/or metabolic neural activity related to the psychiatric disorder occur. Rezai is further limited to placing the electrodes at the site of pathological activity associated with the psychiatric disorder.

Claim 1 is patentable over Rezai because Rezai fails to disclose or suggest several features of this claim. For example, Rezai fails to disclose or suggest selecting a stimulation site at the cortex of the patient where a change in an intrinsic, patient-specific neural activity is suspected of occurring" (emphasis added). In contrast, Rezai does not select a stimulation site based on patient-specific neural activity, but rather Rezai requires determining a treatment site by identifying a common region of the orbital frontal cortex that exhibits pathological electrical and/or chemical activity during manifestations of a specific psychiatry disorder, among a large sampling of patients that each exhibit the psychiatric disorder. Therefore, claim 1 is patentable over Rezai.

Claim 10 includes features generally similar to those of claim 1, including "selecting a stimulation site of the cortex of the patient where a change in an intrinsic, patient-specific neural-activity is expected to occur." Accordingly, the Section 102 rejection of claim 10 on the basis of Rezai should be withdrawn for at least the foregoing reasons and for the additional features of this claim.

C. New Claims 43-51

New claims 43-51 have been added. These claims all depend from claims discussed above. Accordingly, these claims are patentable over the applied references for the reasons discussed above and for the additional features of these dependent claims.

D. Withdrawn Claims

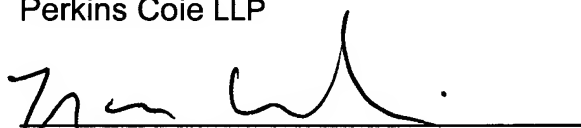
Upon an indication of allowance of claims that are generic to the currently withdrawn claims, applicants expressly request consideration of the withdrawn claims.

E. Conclusion

In view of the foregoing, the pending claims comply with 35 U.S.C. § 112 and are patentable over the cited art. The applicants accordingly request reconsideration of the application, including withdrawn claims, and a Notice of Allowance. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call John Wechkin at (206) 359-3257.

Respectfully submitted,

Perkins Coie LLP



John M. Wechkin

Registration No. 42,216

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Correspondence Address:

Customer No. 25096

Perkins Coie LLP

P.O. Box 1247

Seattle, Washington 98111-1247

(206) 359-8000